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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,238	09/25/2001	Kevin McCarthy	367.40675X00	5762

20457 7590 02/03/2006

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EXAMINER	
RAMAKRISHNAIAH, MELUR	
ART UNIT	**PAPER NUMBER**
2643	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/961,238	MCCARTHY ET AL.	
	Examiner	Art Unit	
	Melur Ramakrishnaiah	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-08-2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 15-17, 19, 20-23, 24-31, 32-35, 37-42, 44, 45 are rejected under 35 U.S.C 102(e) as being anticipated by Holmstorm (US PAT: 6,198,939, hereinafter Holmstorm).

Regarding claim 15, Holmstorm discloses a communication terminal having a function for searching available menu items of the communication terminal, communication terminal comprising: a processor (col. 4 lines 34-37), a user interface (fig. 1) through which the user communicates with the processor, and a memory (not shown) storing computer executable instructions that when executed by the processor

instruct the processor to perform steps comprising: requesting the user to enter commands when user requested a menu item access, automatically performing a search via analyzing the search criteria without receiving a user request to perform the search (col. 4 lines 34-37), automatically presenting a list of menu items matching the entered search criteria, and enabling the user to scroll through the presented list of matching menu items and to select the menu items for being executed by the processor, wherein user4 input is presented in a dialog box (reads on 30, fig. 1) on the communication terminal and input to the processor is made via one of keypad and a voice input (figs. 1-3; col. 1 lines 5-10; col. 2, line 23 – col. 3, line 5; col. 3, line 50 – col. 6, line 49).

Regarding claims 16-17, 19, Holmstrom teaches the following: input to the processor is made via keypad (col. 4 lines 7-9), input to the processor includes characters (figure 3 blocks 311-312 and col. 6 lines 8- 13 and lines 33-40).

Regarding claim 20, Holmstrom discloses a communication terminal (10, figure 1) having at least a function for searching available menu items, comprising a user interface which a user interacts with the communication terminal, the user interface including a display (30, Figure 1) and a keypad (50, figure 1), a processing means controlling the communication terminal including the user interface, and a menu search state which is entered upon requested from the user (figure 3 block 308) wherein the processing means display an invitation for entering search criteria in the display when entering the menu search state, whereupon the user enters a character string containing one or more character via the keypad (figure 3 blocks 311-312), the

processing means automatically performs a match via looking to match the enter search criteria to menu items from the available menu items without receiving user input to activate the search, and the automatically presents a list of menu items matching the entered , i.e., a group of commands or functions beginning with that initial, and offers the items listed to the user group of commands or functions beginning with that initial, and offers the items listed to the user for selection and execution by the user (col. 3 line 50 through col. 5 line 67 and col. 6 line 28 through col. 7 line 7).

Regarding claim 21, Holmstrom discloses the characters string consisting of alphanumeric characters (figure 3 blocks 31 1-312 and col. 6 lines 8- 13 and lines 33-40).

Regarding claims 22-23, Holmstrom discloses the communication terminal mobile terminal, i.e., a mobile phone (figure 1 and col. 3 lines 50-57).

Regarding claim 24, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claim 25, Holmstrom discloses the first means including a keypad including an alphanumeric key (50, figure 1) and soft-keys (51-55, figure 1) including a navigation key, and a display (30, figure 1).

Regarding claim 26, Holnutrom teaches the second means including a processor to monitor activity wherein the processor inherently runs on a program stored in memory (not shown) of the communication terminal (col. 4 lines 38-54).

Regarding claims 27-30, the limitations of the claims are rejected as the same reasons set forth in claims 22-23.

Regarding claim 31, Holrnstrom discloses that the available menu items being stored in a memory of the communication terminal (col. 4 lines 19-26).

Regarding claim 32, the limitations of the claim are rejected œs the same reasons set forth min claim 20.

Regarding claim 33, Holmstrom discloses the menu items being arranged by the processor alphabetically on a display of the communication terminal (figure 5 blocks 510-514 and col. 6 lines 40-44).

Regarding claims 34-35, the limitations of the claims are rejected as the same reasons set forth in claim 25.

Regarding claim 37, Holmstrom discloses a computer readable medium having stored thereon computer readable instructions that when executed by a processor of a communication terminal, instruct the processor to perform steps comprising: entering a menu search state for communication terminal, upon request from a user, including enabling the user to scroll through the available menu items, inviting the user to enter, via a user interface (fig. 1) of the communication terminal, search criteria including one or more characters, automatically performs a search via looking to match entered criteria or that of an edited criteria to menu items from available menu items without receiving user input to activate the search, and automatically presenting a list of menu items matching the entered/edited search data and offering items to the user for selection and execution by the user (figs. 1-3; col. 1 lines 5-10; col. 2, line 23 – col. 3, line 5; col. 3, line 50 – col. 6, line 49).

Regarding claims 38-42, 44-45, Holmstrom further teaches the following: processor automatically performs the search a certain time after the user enters the search criteria (this is implicit as processor takes finite amount of time to search the entered search criteria, note: col. 4 lines 34-37), wherein the computer executable instructions further instruct the processor to perform the step of presenting to the user options for limiting the search to certain areas of menu structure for menu items, wherein the computer readable instructions further instruct the processor to perform the step of receiving user selection of a certain area of menu structure for the search, and for for the step of automatically presenting a list of menu items, the processor only presents menu items within the selected certain area of menu structure (col. 4 lines 15-40).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 18 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom in view of Pisutha-Arnond et al. (GB234527, hereinafter Pisutha-Arnond).

Regarding claims 18 and 36, Holrnstrom differs from the claimed invention in not specifically teaching the user interface including voice activation application. However, it is old and notoriously well known in the art of inputting requests to a processor of a

communication terminal via voice activation application, in order to make user friendly by providing efficient entry of information, for example see Pisutha-Arnond (page 28 lines 3-13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Holnzstrom in having the user interface including voice activation application, as per teaching of Pisutha-Arnond, because it makes user friendly by providing efficient entry of information.

6. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom in view of Davidson et al. (US PAT: 5,841,855, hereinafter Davidson).

Holmstrom differs from claim 43 in that he does not teach the following: computer readable instructions instruct the processor to perform step of presenting an order indication number corresponding to a group of menu items currently being presented to the user and indicating the order of the group within the list of menu items.

However, Davidson discloses menu level indicator for a telephone terminal which teaches the following: computer readable instructions instruct the processor to perform step of presenting an order indication number (reads on menu level indicator) corresponding to a group of menu items currently being presented to the user and indicating the order of the group within the list of menu items (abstract; col. 3 lines 48-62; col. 5 lines 30-48; figs. 1-4).

Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Holnzstrom to provide for the following: computer readable instructions instruct the processor to perform step of presenting an order indication number corresponding to a group of menu items currently being

presented to the user and indicating the order of the group within the list of menu items as this arrangement would facilitate ease of use of a telephone terminal by a user by providing easily understandable information about selectable menu options available in an interactive display on the telephone terminal as taught by Davidson (see abstract).

Response to Arguments

7. Applicant's arguments filed on 12-08-2005 have been fully considered but they are not persuasive.

Rejection of claims 20, 24, 32, 37, under 35 U.S.C 102(e) as being anticipated by Holmstorm (US PAT: 6,198,939, hereinafter Holmstorm):

Regarding independent claims 20, 24, 32, 37, Applicant states that "independent claims 20, 24, 32, 37 as amended each recite the subject matter of automatically performing search based on user entered search criteria without receiving user input to activate the search. As discussed in paragraph 31 of the present application, the example communication terminal embodiment discussed therein may be set to automatically activate a search after the user has entered search criterion, such as after a certain time has elapsed". Applicant then argues that "In contrast, Holmstorm discloses an interface search tool in which the user must instruct the processor to proceed with the search. In particular, the user enters a search command by by inputting the command and "then is prompted to proceed with the search". Col. 6, lines 13-14. proceed by pressing the ... teaches that are searches are manually activated via a command from the user". In response to this argument by the Applicant, Examiner would like to draw attention to paragraph 31 of applicant's specification invoked by the

applicant to establish the premise that his system does the search automatically after finalizing the input. It appears, according to paragraph 31 of applicant's specification, that specifies three options of finalizing the search input, viz: The first option is that user finishes the input, step 203, and activates the search by pressing the left soft-key 9 "search", step 204. The second option is that the user finalizes the input, step 203, and activates the search by using voice activation, step 205. The third option is that the communication terminal has been set to trigger a timer so that input is finalized, step 203 and the search is activated after a certain time has elapsed, step 206, after the user has entered the search criterion, step 202. As can be seen from this specification , option 1 in applicant's specification is met by the Holmstorm teaching, and option 2 is met by the combination of Holmstorm and Pisutha-Arnond combination as set forth in the office action above. The third option that of triggering by timer is not in the claim language of the claims 20, 24, 32, 37. Even if this option, that of triggering by timer is added to the claims, it is not certain applicant can overcome the rejection because, although specification specifies triggering by timer after search criteria is entered, there is no disclosure in the specification how timer is triggered after entering the search criteria. In light of this Holmstorm still teaches applicants amended claims as set forth in the office action above and rejection of claims is maintained.

Regarding rejection of dependent claim 36, applicant's arguments are linked to independent claims 36 on which it depends to be patentable, which is not as set forth in the office action above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melur Ramakrishnaiah
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Art Unit 2643